

Serial No. 10/692,554  
Atty. Docket No. 11333/29

### REMARKS

Claims 42, 44, and 45 are canceled without prejudice to their continued prosecution in a continuation and/or divisional application.

The specification has been amended to include an unintentionally delayed priority reference in accordance with 37 CFR § 1.55. This information has already been recognized by the Office as shown by its inclusion on the official filing receipt, a copy of which is enclosed. Thus, Applicants submit that no petition under 37 CFR § 1.78(a) or surcharge under 37 CFR § 1.17(t) is required to correct this priority claim.

The amendments to claims 26-31, 35-36, 40-41, and 46 are fully supported by the description in the specification.

No new matter has been added. Upon entry of this Response, claims 26-41, 43, and 46 are present and active in the application with claims 29-32 and 36-38 being presently withdrawn as drawn to non-elected species.

#### Request for Personal Interview with Examiner

On page 2 the Response to Office Action dated November 29, 2008, Applicants requested a personal interview with the Examiner in order to discuss the outstanding grounds of rejection prior to the issuance of any further Office Actions. Notwithstanding, a subsequent Office Action dated February 18, 2009 was issued without affording Applicants the opportunity to schedule the requested interview.

Accordingly, unless all of the presently outstanding grounds of objection and rejection are withdrawn in light of the Amendment and Remarks herein, Applicants respectfully reiterate their request for a personal interview with the Examiner in accordance with MPEP § 713.01(III) prior to the issuance of any further Office Actions by the Examiner.

Serial No. 10/692,554  
Atty. Docket No. 11333/29

### **Objection to Drawings**

The objection to the drawings under 37 CFR 1.83(a) as allegedly failing to show every feature of the claimed invention is in part obviated by the amendments adopted herewith and in part respectfully traversed.

The recitation of a "pipette washing unit" has been deleted from the claims. Moreover, Applicants note that the present recitations of "a pipette" comprised by "a sample preparation unit" are clearly shown in each of FIGS. 1, 24, and 27 (e.g., as first pipette 28).

Applicants further note that the recited "detection unit" (e.g., a photomultiplier tube 124 and a photodiode 125) is clearly shown in FIGS. 16 and 17. For example, FIG. 16 clearly depicts the relationship between a photomultiplier tube 124, a photodiode 125, a "fluid supplier" (e.g., sheath fluid container 109 connected to "positive pressure"), and a sheath flow cell 107. In addition, FIG. 17 clearly depicts the relationship between the recited "detection unit" (e.g., a photomultiplier tube 124 and a photodiode 125) and the recited "controller" (e.g., controller 134). Finally, Applicants note that the recited "sample preparation unit" is clearly shown in FIG. 1 (e.g., specification, page 4, lines 32-33).

Accordingly, for at least the reasons set forth above, Applicants respectfully submit that the drawings are in full compliance with 37 CFR 1.83(a). Withdrawal of this ground of objection is respectfully requested.

### **Claim Rejections – 35 U.S.C. § 112, First Paragraph**

1. The rejection of claim 42 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement has been rendered moot by the cancellation without prejudice of this claim. Accordingly, withdrawal of this ground of rejection is respectfully requested.

2. The rejection of claims 27-28 and 41 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement has been obviated by the amendments to claims 27, 28, and 41 adopted herewith.

Serial No. 10/692,554  
Atty. Docket No. 11333/29

In addition, Applicants respectfully draw the Examiner's attention to the description in the specification, which fully supports the subject matter of these claims as presently written. For example, the specification (e.g., page 29, lines 4-9) describes that the inside of first pipette 28 is washed by sheath fluid (i.e., washing solution). However, at the time of washing, the analysis result has not yet been obtained since third pipette 48 has not yet suctioned the analysis sample (e.g., page 30, lines 22-28). In other words, a comparison of the analysis result and the predetermined value is executed *after* pipette 28 has been washed with sheath fluid, such that washing with sheath fluid is executed regardless of the analysis result.

Accordingly, in view of the present amendments, and for at least the reasons set forth above, withdrawal of this ground of rejection is respectfully requested.

**Claim Rejections – 35 U.S.C. § 112, Second Paragraph**

1. The rejection of claims 42 and 44 under 35 U.S.C. § 112, second paragraph, as being unclear for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention has been rendered moot by the cancellation without prejudice of these claims. Accordingly, withdrawal of this ground of rejection is respectfully requested.

2. The rejection of claims 26-28, 33-35, 39-41, 43, and 46 under 35 U.S.C. § 112, second paragraph, as being unclear for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention has been obviated by the claim amendments adopted herewith. Accordingly, withdrawal of this ground of rejection is respectfully requested.

**Claim Rejections – 35 U.S.C. § 102**

1. The rejection of claims 42 and 44 under 35 U.S.C. § 102(b) as being anticipated by *Chupp et al.* (U.S. Patent No. 5,631,165) has been rendered moot by the cancellation without prejudice of these claims. Accordingly, withdrawal of this ground of rejection is respectfully requested.

Serial No. 10/692,554  
Atty. Docket No. 11333/29

2. The rejection of claims 26-28, 33-35, 39-41, 43, and 46 under 35 U.S.C. § 102(b) as being anticipated by *Chupp et al.* has been obviated by amendment. As further explained below, *Chupp et al.* does not teach or suggest each and every element of independent claims 26, 35, 40, and 46 as presently written.

*Chupp et al.* describes a method for performing automated hematology and cytometry analysis. It is noted that *Chupp et al.* does not provide a description of the liquid used for washing aspiration probe 156. Although the Examiner argues in the Final Office Action (page 5, section 7) that *Chupp et al.* describes "acidic solutions" (viz., sulfonic acid buffer, citrate buffer, and acetate buffer), Applicants note that these buffers are merely one of many ingredients that compose the "multipurpose reagent system" described in *Chupp et al.* (e.g., col. 12, line 1 to col. 14, line 47).

With respect to the claimed invention, independent claim 26, as presently written, recites (a) "a solution container holder for holding a solution container comprising an acidic solution used for the diluting of the sample by the sample preparation unit and for washing the pipette"; and (b) "a sample preparation unit" that "prepares the diluted sample by diluting the sample supplied by the pipette with the acidic solution suctioned from the solution container, and washes the pipette by suctioning the acidic solution into the pipette from the solution container"—a combination of elements that is neither taught nor suggested by *Chupp et al.*

Similarly, as presently written, independent claim 35 recites (a) "a solution container holder for holding a solution container comprising an acidic solution used for washing the pipette"; (b) "a controller in communication with the detection unit and configured for obtaining an analysis result relating to a bacterium in the sample from the detection signal obtained by the detection unit"; and (c) "a sample preparation unit" that "washes the pipette by suctioning the acidic solution into the pipette from the solution container"—a combination of elements that is likewise neither taught nor suggested by *Chupp et al.* With respect to element (b), Applicants note that the controller described in *Chupp et al.* obtains a blood cell count—not "an analysis result relating to a bacterium in the sample" as required by independent claim 35.

Serial No. 10/692,554  
Atty. Docket No. 11333/29

Independent claim 40, as presently written, recites (a) "a sample preparation unit comprising a pipette and configured for preparing a diluted urine sample for measurement by diluting the urine sample supplied by the pipette"; (b) "a solution container holder for holding a solution container comprising an acidic solution used for the diluting of the urine sample by the sample preparation unit and for washing the pipette"; and (c) "a sample preparation unit" that "prepares the diluted urine sample by diluting the urine sample supplied by the pipette with the acidic solution suctioned from the solution container, and washes the pipette by suctioning the acidic solution into the pipette from the solution container"—a combination of elements that is neither taught nor suggested by *Chupp et al.* Moreover, with respect to element (c), Applicants note that the sample preparation unit described in *Chupp et al.* prepares a blood sample—not "a diluted urine sample" as required by independent claim 40.

Finally, as presently written, independent claim 46 recites (a) "a solution container comprising an acidic solution used for the diluting of the sample by the sample preparation unit and for washing the pipette"; and (b) "a sample preparation unit" that "prepares the diluted sample by diluting the sample supplied by the pipette with the acidic solution suctioned from the solution container, and washes the pipette by suctioning the acidic solution into the pipette from the solution container"—a combination of elements that is neither taught nor suggested by *Chupp et al.*

Thus, inasmuch as *Chupp et al.* fails to teach or suggest each and every element of independent claims 26, 35, 40, and 46 as presently written, Applicants respectfully submit that the claimed invention is neither anticipated by nor would have been obvious in view of this reference. Accordingly, withdrawal of this ground of rejection is respectfully requested.

### **Double Patenting**

It is respectfully requested that the provisional rejection of claims 26, 35, 40, and 46 on the ground of nonstatutory obviousness-type double patenting over claim 6 of co-pending Application Serial No. 11/729,017 be held in further abeyance until such time as

Serial No. 10/692,554  
Atty. Docket No. 11333/29


allowable subject matter in co-pending Application Serial No. 11/729,017 has been indicated.

**Conclusion**

In view of the Amendment and Remarks set forth above, Applicants respectfully submit that the claimed invention is in condition for allowance. Early notification to such effect is earnestly solicited.

However, if for any reason the Examiner feels that the above Amendment and Remarks do not put the claims in condition to be allowed, it is respectfully requested that the Examiner contact the undersigned agent directly at (312)-321-4257 in order to arrange a personal interview to discuss this case prior to the issuance of any further Office Actions.

Respectfully submitted,

  
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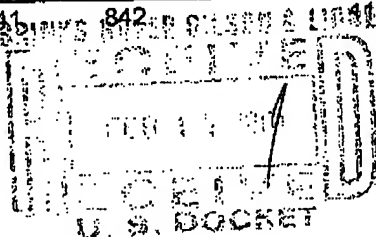


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CONFIRMATION NO. 1129

## FILING RECEIPT

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## Assignment For Published Patent Application

Sysmex Corporation;

## Domestic Priority data as claimed by applicant

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Early Publication Request: No

## Title

Sample analyzers, bacteria analyzers, and solutions for diluting and cleaning

Preliminary Class

436

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